REMARKS

A. 35 U.S.C. § 112, Second Paragraph

In the Office Action mailed on October 6, 2004, claims 1, 29 and 44 were rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. In particular, the term "preferred" was deemed vague and indefinite. Claims 1, 29 and 44 have been amended to clarify that the recited "preferred status" is determined by an insurer. Since claims 1, 29 and 44, as amended, are clear in meaning, the rejection has been overcome and should be withdrawn.

B. 35 U.S.C. § 101

Claims 1-14 and 44-55 were rejected under 35 U.S.C. § 101 because the claims do not claim a technological basis. Claims 1 and 44 have been amended to clarify that the recited displaying at least one line item of an insurance related claim is "via a display of a computer network." Any recited accessing process is performed "from the computer network." Furthermore, the displaying the lists of authorized and excluded lists is performed "via the computer network." The recited receiving process is performed "from the computer network." Since the claims, as amended, clearly claim a technological basis, the rejection has been overcome and should be withdrawn.

Note that claims 1 and 44 have been amended so that "said insurance related claim" reads as "the insurance related claim." The claims have also been amended to correct the Markush language. Since the amendments do not change the meaning or scope of the claim, the amendments are not related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en*

banc), *overruled in part*, 535 U.S (2002).

Note that claims 1-3, 5-14 and 44 have been amended so as to delete references to "step" or "steps" and so are arguably broader in scope and so the scope of the claims regarding such amendments is unaffected per *Festo.*

Note that claim 8 has been amended to correct the Markush language. Since the amendment does not change the meaning or scope of the claim, the amendment is not related to patentability as defined in *Festo*

C. 35 U.S.C. § 103

1. Borghesi et al., McLauchlin et al. and Murcko, Jr.

a. Claims 1-3, 5-9, 11-14, 43, 45-52 and 55

Claims 1-3, 5-9, 11-14, 43, 45-52 and 55 were rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection. Claim 1 recites a method of evaluating line item data that includes 1) "accessing from the computer network a database of excluded vendors and authorized vendors to fulfill the insurance related claim" and 2) "displaying via the computer network a list of authorized vendors and a list of excluded vendors that correspond with the at least one line item, wherein the authorized vendors are selected from the group consisting of vendors with a preferred status as determined by the insurer, franchised vendors, and vendors that allow an upgrade." Borghesi et al. does not disclose accessing a database of excluded vendors. It is noted that the Office Action has not cited one passage in Borghesi et al. that discloses the recited accessing. Furthermore, the Office Action has conceded that Borghesi et al. fails to disclose the recited displaying of a list of excluded vendors.

The Office Action has recited McLauchlin et al. as suggesting modifying Borghesi et al. to display a list of excluded vendors. The Office Action has relied on a passage at page 11 paragraph 0163 of McLauchlin et al. as suggesting the modification. However, McLauchlin et al. regards "an integrated collaborative procurement system and, more particularly, to a system for widely distributed users to exchange data and documents related to contractual relationships and reference data from standard information sources in a self-describing data format" (Page 1, paragraph 0002). McLauchlin et al. is silent as to line items of an insurance related claim. Since the claimed list of excluded vendors relates to the fulfilling of the insurance related claim and the displayed list of excluded vendors "correspond with the at least one line item", McLauchlin et al.'s silence regarding insurance claims and line items of an insurance claim demonstrates that there is no motivation from McLauchlin et al. to alter Borghesi et al. to either access or display a database of excluded vendors as recited in claim 1. Since there is also no motivation in Murcko, Jr. to alter Borghesi et al. to either access or display a database of excluded vendors as recited in claim 1, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that Borghesi et al. fails to disclose both accessing a database of authorized vendors to fulfill an insurance related claim and displaying a list of authorized vendors that correspond with the at least on line item. The Office Action recites a passage at column 12, lines 44-58 of Borghesi et al. as disclosing the recited accessing and displaying. However, the passage relates to creating or editing an estimate, where several databases are accessed automatically. These databases, such as an OEM part database, a recycled part/salvage part database, a labor cost database, an

aftermarket part database, are all accessed to generate an estimate of repairs to a vehicle, or different estimates based upon the types of replacement products that are used. These databases do not represent authorized vendors and so 1) cannot be accessed to provide an authorized vendor for fulfilling an insurance related claim and 2) cannot be used to display a list of authorized vendors corresponding with at least one line item. Since McLauchlin et al. fails to disclose any aspect of fulfilling an insurance related claim, it does not provide any motivation to alter Borghesi et al. to both access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item. Murcko, Jr. also fails to provide any motivation to alter Borghesi et al. to both access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item. Accordingly, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that Borghesi et al. fails to disclose "receiving from the computer network a selection of at least one vendor from the list of authorized vendors to fulfill the insurance related claim." The Office Action has conceded that Borghesi et al. fails to disclose the recited "receiving" process. The Office Action recites a passage at column 10, paragraph 0142 of McLauchlin et al. as suggesting receiving from a computer network a selection of at least one vendor from a list of authorized vendors to fulfill an insurance related claim. However, the passage is silent as to receiving a selection of at least one vendor from a list of authorized vendors to fulfill an insurance related claims. Furthermore, McLauchlin et al. is not related to fulfilling an insurance claim. Murcko, Jr. also fails to provide any motivation to alter Borghesi et al. to receive a selection of at least

vendor from a list of authorized vendors to fulfill an insurance claims. Accordingly, the rejection of claim 1 is improper and should be withdrawn.

Claims 2, 3, 5-9, 11-14, 43, 45-52 and 55 depend directly or indirectly on claim 1 and so their rejections are improper for at least the same reasons that the rejection of claim 1 is improper.

As pointed out in Applicants' Appeal Brief of February 20, 2004, the entire contents of which is incorporated herein by reference, neither Borghesi et al. nor McLauchlin et al. suggest altering Borghesi et al. to include the processes of claims 5-9, 11, 13, 14, 43, 45-48 and 50-52. Since Murcko, Jr. also fails to suggest altering Borghesi et al. to include the processes of claims 5-9, 11, 13, 14, 43, 45-48, 51 and 52, the rejections of claims 5-9, 11, 13, 14, 43, 45-48 and 50-52 are improper for those previously cited reasons as well.

The rejection of claim 50 and its dependent claims is improper for the additional reason that Borghesi et al. fails to disclose executing payment of a selected at least one line item of an insurance related claim via a vendor transfer payment. The Office Action has asserted that FIG. 21 and the several passages at columns 10 and 17-19 of Borghesi et al. disclose a vendor transfer as a form of payment. However, these passages and drawings regard a process of salvaging a vehicle after the claimant has been paid (Col. 10, ll. 14-17, Col. 18, ll. 52-55). Since McLauchlin et al. and Murcko, Jr. each do not suggest altering Borghesi et al. to execute payment of a selected at least one line item of an insurance related claim via a vendor transfer payment, the rejection is improper and should be withdrawn.

b. Claims 15-17, 19-23, 25-28 and 53

Claims 15-17, 19-23, 25-28 and 53 were rejected under 35 U.S.C. § 103 as being

obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection. Claim 15 recites a system that includes a memory that includes a stored program that includes instructions for 1) "accessing a database of vendors having a list of authorized vendors and a list of excluded vendors to fulfill the insurance related claim" and 2) "displaying the list of authorized vendors and the list of excluded vendors that correspond with the at least one line item, wherein the authorized vendors are selected from the group consisting of vendors with a preferred status as determined by the insurer, franchised vendors, and vendors that allow an upgrade." For reasons similar to those given in Section C.1.a, there is no motivation in either McLauchlin et al. or Murcko, Jr. to alter Borghesi et al. to either access or display a database of excluded vendors as recited in claim 15. Accordingly, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that neither McLauchlin et al. nor Murcko, Jr. suggest altering Borghesi et al. to access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item. Reasoning related to this issue is given in Section C.1.a.

The rejection is improper for the additional reason that McLauchlin and Murcko, Jr. each fails to suggest altering Borghesi et al. to receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claim. Reasoning related to this issue is given in Section C.1.a.

Claims 16, 17, 19-23, 25-28 and 53 depend directly or indirectly on claim 15 and so their rejections are improper for at least the same reasons that the rejection of claim 15 is improper.

As pointed out in Applicants' Appeal Brief of February 20, 2004, the entire contents of which is incorporated herein by reference, neither Borghesi et al. nor McLauchlin et al. suggest altering Borghesi et al. to include the system elements of claims 19-23, 25, 27, 28 and 53. Since Murcko, Jr. also fails to suggest altering Borghesi et al. to include the elements of claims 19-23, 25, 27, 28 and 53, the rejections of claims 19-23, 25, 27, 28 and 53 are improper for those previously cited reasons as well.

The rejection of claim 53 and its dependent claims is improper for the additional reason that McLauchlin et al. and Murcko, Jr. each fail to suggest altering Borghesi et al. to execute payment of a selected at least one line item of an insurance related claim via a vendor transfer payment. Reasoning related to this issue is given in Section C.1.a.

Note that claim 15 has been amended so that "said insurance related claim" reads as "the insurance related claim." The claim has also been amended to correct the Markush language. Since the amendments do not change the meaning or scope of the claim, the amendments are not related to patentability as defined in *Festo*.

Note that claim 22 has been amended to correct the Markush language. Since the amendment does not change the meaning or scope of the claim, the amendment is not related to patentability as defined in *Festo*.

c. Claims 29-31, 33-37, 39-42 and 54

Claims 29-31, 33-37, 39-42 and 54 were rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection. Claim 29 recites a computer readable medium containing instructions for 1) "accessing a database of excluded vendors and authorized vendors to fulfill the insurance

related claim" and 2) "displaying a list of authorized vendors and a list of excluded vendors that correspond with the at least one line item, wherein the authorized vendors are selected from the group consisting of vendors with a preferred status as determined by the insurer, franchised vendors, and vendors that allow an upgrade." For reasons similar to those given in Section C.1.a, there is no motivation in either McLauchlin et al. or Murcko, Jr. to alter Borghesi et al. to either access or display a database of excluded vendors as recited in claim 29. Accordingly, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that neither McLauchlin et al. nor Murcko, Jr. suggest altering Borghesi et al. to access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item. Reasoning related to this issue is given in Section C.1.a.

The rejection is improper for the additional reason that McLauchlin and Murcko, Jr. each fails to suggest altering Borghesi et al. to receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance related claim. Reasoning related to this issue is given in Section C.1.a.

Claims 30, 31, 33-37, 39-42 and 54 depend directly or indirectly on claim 29 and so their rejections are improper for at least the same reasons that the rejection of claim 29 is improper.

As pointed out in Applicants' Appeal Brief of February 20, 2004, the entire contents of which is incorporated herein by reference, neither Borghesi et al. nor McLauchlin et al. suggest altering Borghesi et al. to include the computer readable medium elements of claims 33-36, 39, 41, 42 and 54. Since Murcko, Jr. also fails to suggest altering Borghesi et al. to

include the elements of claims 33-36, 39, 41, 42 and 54, the rejections of claims 33-36, 39, 41, 42 and 54 are improper for those previously cited reasons as well.

The rejection of claim 54 and its dependent claims is improper for the additional reason that McLauchlin et al. and Murcko, Jr. each fail to suggest altering Borghesi et al. to execute payment of a selected at least one line item of an insurance related claim via a vendor transfer payment. Reasoning related to this issue is given in Section C.1.a.

Note that claim 29 has been amended so that "said insurance related claim" reads as "the insurance related claim." The claim has also been amended to correct the Markush language. Since the amendments do not change the meaning or scope of the claim, the amendments are not related to patentability as defined in *Festo*.

Note that claims 29-31 and 33-42 have been amended so as to delete references to "step" or "steps" and so are arguably broader in scope and so the scope of the claims regarding such amendments is unaffected per *Festo*.

d. Claim 44

Claim 44 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection. Claim 44 recites a method that includes 1) "accessing a database of vendors having a list of excluded vendors and authorized vendors to fulfill the insurance related claim" and 2) "comparing the list of authorized vendors and the list of excluded vendors with the at least one line item, wherein the authorized vendors are selected from the group consisting of vendors with a preferred status as determined by the insurer, franchised vendors, and vendors that allow an upgrade." For reasons similar to those given in Section C.1.a, there is no motivation in either

McLauchlin et al. or Murcko, Jr. to alter Borghesi et al. to access a database of excluded vendors as recited in claim 44. Accordingly, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that neither McLauchlin et al. nor Murcko, Jr. suggest altering Borghesi et al. to access a database of authorized vendors to fulfill an insurance related claim. Reasoning related to this issue is given in Section C.1.a. The rejection is improper for the additional reason that McLauchlin and Murcko, Jr. each fails to suggest altering Borghesi et al. to receive a selection from a computer network of at least vendor from a list of authorized vendors that corresponds with an at least one item to fulfill an insurance related claim. Reasoning related to this issue is given in Section C.1.a.

The rejection is improper for the additional reason that Borghesi et al. fails to disclose comparing separate lists of authorized and excluded vendors with at least one line item. It is noted that the Office Action has not cited one passage in Borghesi et al. that discloses the recited comparing. Since neither McLauchlin et al. nor Murcko, Jr. suggest altering Borghesi et al. to compare separate lists of authorized and excluded vendors with at least one line, the rejection is improper and should be withdrawn.

2. Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al.

a. Claim 10

Claim 10 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 10 depends indirectly on claim 1. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and

Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 1, 2) both access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claim. Accordingly, the rejection is improper and should be withdrawn.

b. Claim 24

Claim 24 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 24 depends indirectly on claim 15. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 15, 2) access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claim. Accordingly, the rejection is improper and should be withdrawn.

c. Claim 38

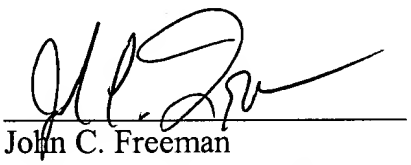
Claim 38 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 38 depends indirectly on claim 29. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 29, 2) access a database of authorized

vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claims. Accordingly, the rejection is improper and should be withdrawn.

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-3, 5-17, 19-31 and 33-55 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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